

REMARKS/ARGUMENTS

Response to Restriction Requirement

Claims 1, 2, and 9, corresponding to Group I of the communication of June 24, 2002, have been elected and remain pending. Claim 2 has been limited to the method of claim 1 wherein the compound is not an estrogen compound that induces estrous and does not induce significant androgenic gene transcriptional activity. New claims 46 and 47 have been added, listing specific compounds, including the elected compound estratriene-3-ol.

It appears that there has been some confusion regarding claims multiply restricted by the Examiner and elected by the Applicants in the course of three office actions. In the communication of August 17, 2001, the Examiner required restriction between inventions of Group I (claims 1-10 and 13-45) to methods of increasing bone mass, and Group II (claims 11-12), drawn to assays to select active compounds. In response, Applicants elected to prosecute Group I claims. In the communication of June 24, 2002, the Examiner required further restriction between Group I (now claims 2, 5, 9 to non-estrogenic compounds); Group II (claims 2-4 to estrogen compounds); Group III (claim 6 to non-androgen compounds); Group IV (claims 7, 10 to androgens); and Group V (claims 13-29 to specific bicyclic compounds to treat bone). The Examiner indicated that claims 1 and 30-37 would be examined with Group I. In response, Applicants elected Group I claims, however inadvertently mischaracterized the claims to be examined as only including 1 and 30-37. Because claim 5 was canceled, the claims elected should have been claims 1, 2, 9, and 30-37. The Examiner has apparently also erred in his most recent communication by characterizing the claims presented as 1-4, 6, 7, 9, 10, and 13-37, and indicating that Group I claims elected by Applicants only included claims 2 and 9 (as claim 5 is

cancelled). The Examiner thereafter withdrew claims 1 and 30-37 from consideration. Applicants requests that this error be corrected and that the claims listed in the "listing of claims" attached to this amendment be considered pending in this application. These claims are drawn to non-estrogen compounds to increase bone mass, specifically to claims of Group I as characterized by the Examiner on June 24, 2002.

The Examiner indicated that further restriction is required, however did not indicate which of the pending claims (based on the Applicants' election of November 25, 2002) require restriction. Rather, the Examiner's communication appears to suggest that an election of species is required. Applicants hereby elects estratriene-3-ol indicated in new claim 47 as a species to focus the examination on.

After three Restriction Requirements, Applicants sincerely hope that this case is in condition for prosecution.

Respectfully submitted,
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